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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,761	03/22/2004	Tanna Marie Richardson	SLA1564	1251
7590 Gerald W. Maliszewski P.O. Box 270829 San Diego, CA 92198-2829				
EXAMINER SHAN, APRIL YING				
ART UNIT 2135		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/805,761

Applicant(s)

RICHARDSON, TANNA MARIE

Examiner

APRIL Y. SHAN

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,7,8,10,12,13,17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,7,8,10,12,13,17 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 June 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. A Request for Continued Examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 19 June 2008 has been entered.

2. Claims 1, 7, 10, 13, 16 and 17-18 have been amended. Claims 2, 5-6, 9, 11, 14-15 and 19 are canceled. No new claims have been added. Claims 1, 3-4, 7-8, 10, 12-13 and 16-18 are currently pending in the present application.

3. Applicant's amendments and argument have been respectfully and fully considered, but are moot in view of new ground rejection as set forth below. It is noted that Applicant's arguments are directed towards limitations newly added via amendments. Any well known art statements from the last office action not argued by the Applicant are taken as admittance of prior art as per MPEP 2144.03.

Drawings

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the feature of "creating

password" must be shown or the feature(s) canceled from the claim(s). **No new matter should be entered.**

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Admitted Prior Art

5. The examiner acknowledges Applicant's Admitted Prior Art of figure 1 and line 10, page 1 – line 3, page 2 of Applicant's original disclosure.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1, 3-4, 7-8, 10, 12-13 and 16-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As per **claims 1, 7, 10, 13 and 16**, "creating a password for transmission" and "the password created for transmission" are being recited. However, the examiner carefully and respectfully reviewed the Applicant's original disclosure and cannot find support for these amended claim limitations. For example, according to figure 4 and lines 13-14 on page 3 of Applicant's original disclosure, it recites "accepting a password". "creating a password" and "accepting a password" are different. Therefore, the examiner finds no support in the original disclosure of newly amended claim limitations of "creating a password for transmission" and "the password created for transmission".

The Applicant is respectfully reminded that "When filling an amendment an applicant should show support in the original disclosure for new or amended claims."
M.P.E.P. § 2163.II.A.3 (b).

Any claim not specifically addressed, above, is being rejected as incorporating the deficiencies of a claim upon which it depends.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 1, 3-4, 8, 10, 12-13 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGraw (U.S. Patent No. 6,542,261) in view of Applicant's Admitted Prior Art and further in view of Chan et al. (U.S. Patent No. 6,378,070)

As per **claims 1 and 10**, McGraw discloses a method/system, comprising:
at a source, scanning a document ("The document to be sent via secure FAX in accordance with the present invention is scanned by the sender's FAX machine or other scanning device" - e.g. col. 2, lines 53-55);

creating a password ("In general, the sender of the FAX enters a "code" into either a FAX machine's control panel or an associated computer which is running a secure FAX software package. The code is known by the intended recipient of the FAX..." – e.g. col. 2, lines 48-53. Please note a code corresponds to Applicant's password. Further, to an ordinary skill in the art, "creating" a password can be broadly interpreted as creating a password by entering a password);

encrypting the scanned document, creating an encrypted document ("The scanned data is encrypted via one of a variety of known encryption techniques...." - e.g. col. 2, lines 55-58); and,

transmitting a file including a file header with an unencrypted identification of the encrypted document, and the encrypted document (e.g. col. 3, lines 54-58, "An unencoded header containing, at least, information describing who the intended recipient of the FAX document and who the FAX document is from, along with other pertinent information is included" and in col. 3, lines 6-11, "The printed or viewed received FAX will have the unencrypted header at the top of the page so that the receiving party (who may not be the intended recipient) will know to whom the received secure FAX document should be given to. For example a hotel's business center would need to know which guest the secure FAX should be delivered to. and col. 1, line 67 – col. 2, line 10, col. 2, line 59 - col. 3, line 18 and col. 6, lines 27-36), from the source to a network-connected printer ("The secure FAX data (secure bit map and header) is sent as a normal FAX to a communication system 16. The communication system can be ...internet system or any communication system that can or is adopted

to carry out a FAX transmission" - e.g. col. 3, lines 58-64, "The CPU 64, memory 68 and scanner may all be contained in a multifunction printer/scanner/FAX machine" – e.g. col. 4, lines 64-65, fig. 2 and FAX machine 30 is connected to communication system 16 in fig. 1. Please note internet system is the worldwide, publicly accessible network and therefore, FAX machine 30 is a network-connected printer).

at the printer, accepting the file from the source (e.g. col. 6, lines 34-53);

storing the encrypted document in printer memory until a user enters a password matching the password created for transmission (e.g. col. 5, lines 21-25, col. 5, lines 36-42);

accepting the password from the user at a printer local interface (e.g. col. 6, lines 53-56);

Although McGraw does not use the word "electronic file", the reference implicitly discloses the file transmitted is an "electronic file" by suggesting "The FAX encryption process, along with the header information, are combined to produce a secure FAX **data stream** in standard FAX data format. The secure FAX data stream...could be sent **via the internet** as a FAX document" (e.g. col. 2, line 66 – col. 3, line 3). To an ordinary skill in the art at the time of the invention, any file sent via the internet is an electronic file.

In order to make record clearer, Applicant's Admitted Prior Art discloses "Multifunctional peripherals...**fax machines**...often have a network scanning

function that permits a user to scan paper documents, and send them **electronically**...on the network. **Generally**, this type of communication is known as scan to...technology...This functionality is similar to the fax paradigm, but without long distance charges, because **Internet** technology is used" (e.g. lines 10 -18 on page 1 of Applicant's Admitted Prior Art).

It would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate Applicant's Admitted Prior Art's electronic file into McGraw motivated by "enables users to scan a document on one MFP and print it out at another location" (e.g. lines 15-17 on page 1 of Applicant's Admitted Prior Art).

McGraw further discloses in col. 6, lines 53-55 "In step S26, the user is queried for the code (decryption code) that must be used to decrypt the encrypted bit map/bit stream into a human readable document". Inherently, there must be some kinds of comparison step to verify the code is the correct code to decrypt the document.

McGraw – Applicant's Admitted Prior Art does not expressly disclose transmitting a password and the file includes a password and comparing the access code to the password in the file.

Chan et al. discloses the file includes a password and comparing the access code to the password in the file ("...to transmit to the print server the document **accompanied by a first identifier** for the intended recipient...comparing the second identifier with the stored first identifier..." - e.g. col. 2, lines 15-34 and "In step 345, the secure printing process forwards across the network 110, to the document store

130, a message comprising the encrypted document, an 'envelop' for the document...and the respective identity of the intended recipient...it would be typical...to request entry by the recipient of a personal identification number, to verify that the recipient is the genuine owner of the smart card...reads the smart card...extracts the identity...searches...for any documents having the same identify..." – e.g. col. 6, line 48 – col. 7, 50).

It would have been obvious to a person with ordinary skill in the art at the time of the invention to combine Chan et al.'s well known features of file includes a password and comparing the access code to the password in the file with McGraw – Applicant's Admitted Prior Art in order to "increase the security of remote printing" (Chan et al. col. 2, lines 7-8).

McGraw – Chan et al. further discloses in response to a matching the passwords, decrypting the encrypted document; and printing the decrypted document (e.g. McGraw, col. 6, lines 57-62 and Chan et al., col. 7, lines 1-51).

As per **claims 3 and 12**, McGraw – Applicant's Admitted Prior Art - Chan et al. discloses a method/system as applied above in claims 1 and 10. Chan et al. further discloses wherein accepting a password includes accepting a password selected from the group including a PIN number, an alphanumeric code, biometric data, Smart card, magnetic stripe card, and proximity badge (e.g. abstract and col. 2, lines 48-53).

As per **claims 4 and 13**, McGraw – Applicant's Admitted Prior Art - Chan et al. discloses a method/system as applied above in claims 1 and 10. McGraw further

discloses wherein encrypting the document includes: at the source, deriving an encryption key from the password; and,

using the encryption key to encrypt the document (e.g. col. 1, lines 64-67 and col. 2, lines 47 - 58).

As per **claim 8**, McGraw – Applicant's Admitted Prior Art - Chan et al. discloses a method/system as applied above in claims 1 and 16. McGraw further discloses wherein decrypting the document includes:

regenerating the encryption key from the access code; and,
using the encryption key to decrypt the encrypted document (e.g. col. 6, lines 53 -56).

As per **claim 18**, McGraw – Applicant's Admitted Prior Art - Chan et al. discloses a system as applied above in claim 11. Chan et al. further discloses wherein the printer user interface accepts an access code selected from the group including a PIN number, an alphanumeric code, biometric data, Smart card, magnetic stripe card, and proximity badge (e.g. abstract and col. 2, lines 48-53).

11. Claims 7, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGraw (U.S. Patent No. 6,542,261) in view of Applicant's Admitted Prior Art - Chan et al. (U.S. Patent No. 6,378,070) and further in view of Eldridge et al. (U.S. Patent No. 5,787,169).

McGraw – Applicant's Admitted Prior Art - Chan et al. discloses a method/system as applied above in claims 1 and 10. Chan et al. further implicitly discloses at the

source, hashing the password created for transmission and at the printer, entering the password accepted at the printer local interface; and, wherein comparing the password accepted at the printer local interface to the password created for transmission includes comparing the hash passwords ("...This can be achieved using a message digest function such as the **Secure Hash Algorithm (SHA-1)**..." – e.g. col. 6, lines 15-28 and col. 6, line 48 – col. 7, 50).

In order to make record clearer, Eldridge et al. discloses in col. 7, lines 16-36.

"In a system in which encrypted information can be protected...a file with secure data contains both an unencrypted header and encrypted data portion. The data portion contains both the secured data and a list of hashed passwords...During use of the system, an authorized user must enter a password which, when hashed, can be found..." – e.g. abstract, "When a user enters a password...the entered password is...hashed...to generate **HASH**... Decision block 510 checks to see if the hashed password just computed matches any of the hashed passwords retrieved from the file header...", which met the claimed limitation of hashing passwords and comparing hashed passwords.

It would have been obvious to a person with ordinary skill in the art at the time of the invention to combine Eldridge et al.'s hashing passwords and comparing hashed passwords into McGraw – Applicant's Admitted Prior Art - Chan et al. motivated by to enhance ssecurity since it is extremely unlikely that two different passwords, however close, will have the same hash.

The examiner respectfully points out a person with ordinary skill in the art is someone having common sense and ordinary creativity (*KSR v. Teleflex 550 U.S.*, 127 S. Ct. 1727 (2007)) will easily recognize that the steps/elements in claims 7 and 16 are merely "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR* at 1739

As per **claim 17**, McGraw – Applicant's Admitted Prior Art - Chan et al. - Eldridge et al. disclose a system as applied above in claim 16. McGraw further discloses wherein decrypting the document includes:

regenerating the encryption key from the access code; and,
using the encryption key to decrypt the encrypted document (e.g. col. 6, lines 53-56).

12. Claims 7, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGraw (U.S. Patent No. 6,542,261) in view of Applicant's Admitted Prior Art - Chan et al. (U.S. Patent No. 6,378,070) and further in view of Kaufman (U.S. Patent No. 5,666,415).

As per **claims 7 and 16**, McGraw – Applicant's Admitted Prior Art - Chan et al. discloses a method/system as applied above in claims 1 and 10. Chan et al. further implicitly discloses at the source, hashing the password created for transmission and at the printer, entering the password accepted at the printer local interface; and, wherein comparing the password accepted at the printer local interface to the password created

for transmission includes comparing the hash passwords (“...This can be achieved using a message digest function such as the **Secure Hash Algorithm (SHA-1)**...” – e.g. col. 6, lines 15-28 and col. 6, line 48 – col. 7, 50).

In order to make record clearer, Kaufman discloses in col. 2, lines 48-58 and col. 3, lines 12-17, “Because there is no way in which the transformation may be reversed, hash functions are typically used where a user is simply proving its knowledge of something such as a password, which the receiver also knows. The user applies a hash function to the password and sends the result to the recipient. The recipient either has the hash of the password stored with which to compare or, the recipient also applies the hash function to the password it is expecting to receive and simply compares the result to the hash of the password sent by the user. In this way knowledge of a secret (password) may be shown by the user to the recipient.”, which met the claimed limitation of hashing passwords and comparing hashed passwords.

It would have been obvious to a person with ordinary skill in the art at the time of the invention to combine Kaufman’s hashing passwords and comparing hashed passwords into McGraw – Applicant’s Admitted Prior Art - Chan et al. motivated by to enhance ssecurity since it is extremely unlikely that two different passwords, however close, will have the same hash.

The examiner respectfully points out a person with ordinary skill in the art is someone having common sense and ordinary creativity (*KSR v. Teleflex 550 U.S.*, 127 S. Ct. 1727 (2007)) will easily recognize that the steps/elements in claims 7 and 16 are

merely "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR* at 1739

As per **claim 17**, McGraw – Applicant's Admitted Prior Art - Chan et al. - Kaufman discloses a system as applied above in claim 16. McGraw further discloses wherein decrypting the document includes:

regenerating the encryption key from the access code; and,
using the encryption key to decrypt the encrypted document (e.g. col. 6, lines 53-56).

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (See PTO -892)

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to APRIL Y. SHAN whose telephone number is (571)270-1014. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/April Y Shan/
Examiner, Art Unit 2135

/KimYen Vu/

Supervisory Patent Examiner, Art Unit 2135